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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/606,573

**Applicant(s)**

KARAKASHIAN ET AL.

**Examiner**

PELING A. SHAW

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 08/31/2007.

### **DETAILED ACTION**

1. Amendment received on 08/31/2007 has been entered into record. Claims 1-12, 14-16 and 20 are amended. Claims 21-23 are new. Claims 1-23 are currently pending.

#### ***Priority***

2. This application is a CIP of 10/366,236 filed on 02/13/2003 which claims benefit of 60/359,098 filed on 02/22/2002 and claims benefit of 60/392,217 filed on 06/27/2002. The filing date is 06/26/2003.

#### ***Election/Restriction***

3. Applicant has amended independent claims 1, 11 and 20 with the limitations of “a plurality of components each of which includes corresponding content” and “modifies the content of one or more of the components of the initial message context ...” that is not readily found in applicant’s original specification and claim language. Examiner has rejected these limitations under 35 U.S.C. 112, first paragraph as in section 4 below. Applicant has further added claims 21-23 citing limitations based on the concept of “component”. This is evidence of intention to direct the claimed invention beyond as original presented, e.g. ‘request message component’, “response message component”, “transport information component”, “invocation context component” and broad or specific modification on components. These functional limitations directed to the specification of message context in component level and its operation that are directed to an invention that is not supported by applicant original specification and claim language and is independent or distinct from the invention originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, the newly added claims 21-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112, first paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the original specification and claims in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Claims 1, 11 and 20 are amended with the limitation of “the initial message context including a plurality of components each of which includes corresponding content, and modifies (modifying) the content of one or more of the components of the initial message context to produce modified message context for the web service, the modified message context including the same plurality of components as the initial message context but with the content of one or more components differing from the initial message context” that is not found in the original specification or claims. This change modifies the scope of the invention and introduces new subject matter into the application. It would require undue experimentation for one of ordinary skill in the networking art at the time the invention was made to be able to add and test all these functions inclusively rather than just pick a particular function for implementation.

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Claims 1, 11, 20, their depending claims 2-10, 12-19 and 21-23 are thus rejected. For the purpose of applying art, the claims are read with the consideration of the limitation.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Amirisetty et al. (US 7152090 B2), hereinafter referred as Amirisetty.

- a. Regarding claim 1, Amirisetty disclosed a storage medium including software system applications for providing access to web services (column 1, lines 52-56: J2EE CA), comprising: a container driver that accepts invoke request for a web service from a client (column 1, lines 60-62: CCI; column 5, lines 54-61: invoke through J2EE CA connector), an interceptor that receives initial message context for the invoke request for the web service from said container driver, the initial message context including a plurality of components each of which includes corresponding content, and modifies the content of one or more of the components of the initial message context to produce modified message context for the web service, the modified message context including the same plurality of components as the initial message context but with the content of one or more components differing from the initial message context (column 6, lines 8-18: modify metadata content; in light of applicant's paragraph 27

- of specification; Fig. 7, column 15, lines 55 through column 16, line 45: flowchart illustrating using a metadata-aware Enterprise Application Integration built on top of adaptor/connector for external system interface and data object transformed from business XML to XML protocol); and an invocation handler that receives the modified message context from said container driver, passes parameters from the modified message context to the target of the request, processes values returned from the target, and passes the values to the container driver, such that the container driver can formulate a response to the invoke request (Fig. 4; column 6, line 63-column 7, line 17: high-level function invoke low-level calls in sequence through connector; column 8, lines 10-21: sequence of low-level function calls perform high-level function and return results).
- b. Regarding claim 2, Amirisetty disclosed the storage medium of claim 1 wherein the client utilizes JAX-RPC to invoke the web services (Fig. 3; column 13, lines 13-25: server wrapper receives JAX-RPC).
  - c. Regarding claim 3, Amirisetty disclosed the storage medium of claim 1 wherein said container driver is adapted to perform any data binding and unbinding required to process the invoke request (column 12, lines 12-20 and 44-55: JAXB).
  - d. Regarding claim 4, Amirisetty disclosed the storage medium of claim 1, further comprising a protocol adapter that intercepts web service invoke requests and passes the web service invoke requests to said container driver (column 9, lines 14-20: CCI adaptor provide a unified representation; lines 44-46: see Business XML; column 10, lines 30-35: convert Business XML to protocol XML).

- e. Regarding claim 5, Amirisetty disclosed the storage medium of claim 4, wherein said protocol adapter converts the format of an invoke request and create a message context containing the invoke request (column 9, lines 14-20: CCI adaptor provide a unified representation; lines 44-46: see Business XML; column 10, lines 30-35: convert Business XML to protocol XML).
- f. Regarding claim 6, Amirisetty disclosed the storage medium of claim 1, further comprising a plugin component to be used by said container driver to perform any data binding and unbinding (column 10, lines 30-42: pluggable JAXB).
- g. Regarding claim 7, Amirisetty disclosed the storage medium of claim 1, further comprising an invocation context for storing arbitrary context data useful in processing the web request, said invocation context available to at least one of said interceptor and said invocation handler (column 11, lines 27-35: metadata stored in metadata repository).
- h. Regarding claim 8, Amirisetty disclosed the storage medium of claim 1, wherein said invocation handler manages security policies, transaction management, and target object life cycle for the request (column 1, lines 52-60: managing resource pooling, transactions and security).
- i. Regarding claim 9, Amirisetty disclosed the storage medium of claim 1, further comprising a web service container for hosting said container driver, said interceptor, and said invocation handler (column 1, lines 52-60: J2EE CA in Web/Application server).



- j. Regarding claim 10, Amirisetty disclosed the storage medium of claim 1, further comprising a target object to which said invocation handler can delegate processing the invoke request (column 13, lines 13-25: request payload as input to target function).
- k. Claim 11 and 20 are of the same scope as claim 1. These are rejected for the same reasons as for claim 1.
- l. Claims 12-19 are of the same scope as claims 1-5 and 7-10. These are rejected for the same reasons as for claims 1-5 and 7-10.

Amirisetty disclosed all limitations of claims 1-20. Claims 1-20 are rejected under 35 U.S.C. 102(c).

***Response to Arguments***

6. Applicant's arguments filed on 08/31/2007 have been fully considered, but they are not persuasive.
- a. Applicant has amended independent claims 1, 11 and 20 with the limitation of "the initial message context including a plurality of components each of which includes corresponding content, and modifies (modifying) the content of one or more of the components of the initial message context to produce modified message context for the web service, the modified message context including the same plurality of components as the initial message context but with the content of one or more components differing from the initial message context" and pointed to paragraph 27 of applicant's specification for support. The message context as per paragraph 27 of applicant's specification seems to represent a series of message exchanges. It does depict as the amended change as quoted above. Particularly, the term of "component" is used applicant's specification in referring software functionality. Thus it is not clearly described as applicant's may intend do, e.g. as per paragraph 27 of applicant's specification. Also the amended limitation in conjunction with paragraph 27 of applicant's specification seems to deviate from the original claim set. Amirisetty has shown applicant's original claimed invention as per claim rejections in item a of section 5 of office action dated 05/01/2007. The description per paragraph 27 of applicant's specification seem to be disclosed as per Fig. 7 and related description of Amirisetty. However, the amended limitation is neither supported as per paragraph 27 nor as per other sections of applicant's specification. Thus, the current claim set is

rejected under 35 U.S.C. 112, first paragraph. As for newly added claims 21-23 further built upon this limitation seems intend to further expand the current application beyond the scope of its original claimed invention, these claims are restricted from consideration.

- b. Applicant has argued as per page 11 to the top of page 12 of current amendment based upon the amended limitation quoted in item a above. It is not sure with which context, i.e. either previous claim set or current claim set, that applicant is arguing about. Examiner has reviewed previous claim rejection, particularly item a of section 5 of office action dated 05/01/2007 seems to still cover the argument of modifying the message as per applicant's previous claim 1 language. Amirisetty's Fig. 7 and column 15, lines 55 through column 16, line 45 have shown a flowchart illustrating using a metadata-aware Enterprise Application Integration built on top of adaptor/connector for external system interface and data object transformed from business XML to XML protocol as further depicted with Fig. 5 and 6. This seems to match with as per paragraph 27 of applicant's specification in conjunction with applicant's original claim 1 limitation of modifying the message. As for applicant's argument per bottom of page 11 to the top of page 12 of current amendment, it is based upon the amended limitation as not supported as per applicant's original specification and claim language, including as per paragraph 27 of applicant's specification. Amirisetty's Fig. 5-7 and column 13, line 65 through column 16, line 45 seems to cover the amended limitation.

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- c. Applicant has noted amending similar claim changes in independent claims 11 and 20. The argument and response as per items a-b should apply.

***Remarks***

7. The following pertaining arts are discovered and not used in this office action. Office reserves the right to use these arts in later actions.

- a. Banerjee et al. (US 20030131049 A1) Internationalization of the web services infrastructure
- b. Baller et al. (US 20030118353 A1) Method and apparatus for managing intelligent assets in a distributed environment
- c. Brown et al. (US 20030110242 A1) Method and apparatus for dynamic reconfiguration of web services infrastructure
- d. Brittenham et al. (US 20020178254 A1) Dynamic deployment of services in a computing network
- e. Humpleman et al. (US 6466971 B1) Method and system for device to device command and control in a network; web service
- f. Faccin et al. (US 20020120729 A1) Internet protocol based service architecture
- g. Merrick et al. (US 7028312 B1) XML remote procedure call (XML-RPC)

***Conclusion***

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/P. A. S./

Patent Examiner, Art Unit 2144

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144